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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,500	11/09/2001	Timothy A. Estes		5590

7590

02/08/2005

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Albuquerque, NM 87111

EXAMINER

ANANTHANARAYANAN, RAMYA

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,500

Applicant(s)

ESTES ET AL.

Examiner

Ramya Ananthanarayanan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 1-7 have been examined.
2. All correspondence and interaction with the United States Patent and Trademark Office must be in compliance with CFR 1.4(d). Thus, all correspondence and interaction with the United States Patent and Trademark Office must be inclusive of all inventors involved with the patent application unless a limited power of attorney granted to one inventor from all other inventors in the party is disclosed. This includes but is not limited to the requirements that all inventors must sign all papers sent to the United States Patent and Trademark Office, and all inventors must participate in any interviews conducted.

Specification

3. The disclosure is objected to because it contains several embedded hyperlinks on pages 1 and 2 of the specification. Applicant is required to delete the embedded hyperlinks and/or other form of browser-executable code. See MPEP § 608.01.
4. Claim 7 is objected to because of the following informalities: There is a typographical error in claim 7, where the words "said address" should be "said addressee". The examiner will treat the claim as though the typographical error were corrected. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-7 recite the limitations "said e-document" and "said encrypted e-document". These limitations are cited in lines 4, 5, 7, 8, and 10 of claim 1, lines 2 and 3 of claims 2 and 3, lines 1 and 2 of claim 4, lines 2 and 4 of claim 5, lines 2-4 of claim 6, and line 2 of claim 7. There is insufficient antecedent basis for this limitation in the claim. Claim 5 recites the limitation "said decrypted document" in line 6 for which there is insufficient antecedent bases. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being unpatentable over Muftic (U.S. Patent 5,943,423) in view of Richardson.

9. Muftic and Richardson are analogous art because both are in the field of secure electronic communication.

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10. With respect to claim 1, Muftic discloses a method of authenticating, via an authentication service, the contents of a document sent by an originator to at least one addressee, said method including the steps of:

(a) Sending, via e-mail (column 7, lines 24-32), said e-document to said addressee (column 4, lines 56-59);

(b) Sending a copy of said e-document to said authentication service (column 4, lines 61-63);

Muftic does not disclose:

(b) Sending, via e-mail, said e-document to said authentication service;

(c) Encrypting said copy of said e-document;

(d) Sending, via e-mail, said encrypted e-document to said addressee; and

(e) Sending, via e-mail, said encrypted e-document to said originator.

Richardson discloses:

(b) Sending, via e-mail, said e-document to said authentication service (Paragraph 2 under the heading "Introduction", lines 1-3);

(c) Encrypting said copy of said e-document (Paragraph 1 under heading "Using the service in Post Mode");

(d) Sending, via e-mail, said encrypted e-document to said addressee (paragraph 4 under "Using the service in Post Mode" (last paragraph on the page), lines 1-3); and

(e) Sending, via e-mail, said encrypted e-document to said originator (paragraph 4 under "Using the service in Post Mode" (last paragraph on the page), lines 1-3).

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11. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Richardson with the teachings of Muftic in order to provide a free service that did not use proprietary software (paragraphs 1 and 2 under "Introduction").

12. With respect to claim 3, Muftic discloses a method wherein during the steps of encrypting and sending by said authentication service, no information on said e-document or said encrypted e-document is retained by said authentication service (column 18, lines 12-18).

13. Claims 2 and 4 - 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muftic (U.S. Patent 5,943,423) and Richardson in view of Zabetian (U.S. Patent 6,327,656).

14. Muftic, Richardson and Zabetian are analogous art because all are in the field of secure electronic communication.

15. With respect to claim 2, Muftic and Richardson disclose the limitations of claim 1, upon which claim 2 is dependent. Neither Muftic nor Richardson disclose a method wherein during the steps of encrypting and sending by said authentication service, no copy of said e- document or said encrypted e-document is retained by said authentication service. Zabetian discloses a method wherein during the steps of encrypting and sending

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by said authentication service, no copy of said e- document or said encrypted e-document is retained by said authentication service (column 10, lines 4-7).

16. It would have been obvious for one of ordinary skill in the art at the time of the invention to have combined the teachings of Zabetian with the combined teachings of Muftic and Richardson in order to keep the files saved by the authentication service small and easy to handle (column 9, lines 18-19).

17. With respect to claim 4, Muftic discloses the limitations of claim 1, upon which claim 4 is dependent. Neither Muftic nor Richardson disclose a method further including the step of saving said encrypted e-document by one or more of said originator and said addressee. Zabetian discloses a method further including the step of saving said encrypted e-document by one or more of said originator and said addressee (column 9, line 59).

18. It would have been obvious for one of ordinary skill in the art at the time of the invention to have combined the teachings of Zabetian with the combined teachings of Muftic and Richardson. The motivation for such a combination would have been to lessen the likelihood of loss of the identification code of the certified document (column 10, lines 54-57).

19. With respect to claim 5, neither Muftic nor Richardson disclose a method further including steps of:

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- (a) Sending, via e-mail, said encrypted e-document to said authentication service;
- (b) Decrypting said encrypted e-document by said authentication service; and
- (c) Sending, via e-mail, said document to said originator and said addressee.

Zabetian discloses a method further including steps of:

- (a) Sending, via e-mail, said encrypted e-document to said authentication service (column 12, lines 27-29);
- (b) Decrypting said encrypted e-document by said authentication service (column 13, lines 3-16); and
- (c) Sending, via e-mail, said decrypted document (column 13, lines 51-63) to said originator and said addressee (column 13, lines 45-46; column 11, lines 51-53).

20. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Zabetian with the combined teachings of Muftic and Richardson in order to verify that the electronic mail document was sent (column 9, lines 11-12).

21. With respect to claim 6, neither Muftic nor Richardson disclose a method further including the step of, prior to said decrypting, determining whether said encrypted e-document as received by said authentication service has been modified, and decrypting only said encrypted e-document if it has not been modified. Zabetian discloses a method further including the step of, prior to said decrypting, determining whether said encrypted e-document as received by said authentication service has been modified, and

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decrypting only said encrypted e-document if it has not been modified (column 13, lines 3-9).

22. Please see above for the motivational benefit of combining the teachings of Zabetian with the combined teachings of Muftic and Richardson.

23. With respect to claim 7, neither Muftic nor Richardson disclose a method further including the step of notifying said originator and said address that said encrypted e-document as received by said authentication service has been modified and cannot be decrypted. Zabetian discloses a method further including the step of notifying said originator and said address (column 13, lines 45-46; column 11, lines 51-53) that said encrypted e-document as received by said authentication service has been modified and cannot be decrypted (column 13, lines 47-68 to column 14 lines 1-27).

24. Please see above for the motivational benefit of combining the teachings of Zabetian with the combined teachings of Muftic and Richardson.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following non-patent literature was cited by the examiner: Netbill Security and Transaction Protocol (Cox, B., Tygar, J.D., Sirbu, M., Carnegie Mellon University Information Networking Institute.).

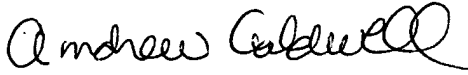
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramya Ananthanarayanan whose telephone number is (571) 272-5860. The examiner can normally be reached on Monday through Friday, 8:30 -5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RA


ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER